

**Remarks**

This Application has been carefully reviewed in light of the Office Action mailed December 15, 2006. Applicants have made clarifying amendments to Claims 9 and 17 to correct typographical errors present in those claims. These amendments are not considered narrowing or necessary for patentability, and they are not made in relation to any rejection raised by the Examiner. Applicants believe all claims are allowable over the Examiner's rejections without amendment and respectfully provide the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

**I. Claims 1-62 are Definite**

The Examiner rejects Claims 1-62 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse these rejections.

The essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). For at least the reasons discussed below, Applicants respectfully submit that Claims 1-62 are definite.

First, the Examiner states that the "claims are directed to a recording plan based upon the presence of a client. The claims are not clear as to whether the client is a third party, or merely an operator of [a] calling system." (Office Action, Page 2)

Applicants respectfully submit that it is not necessary for Applicants to limit the scope of the term "client" to any particular type of client for Applicants' claims to be definite.

Moreover, Applicants do not concede that the two options for the term “client” proposed by the Examiner (i.e., a third party or merely an operator of a calling system) are the only two options for the meaning of the term client in Applicants’ claims. Applicants respectfully submit that those of ordinary skill in the art would understand the meaning of the term “client,” as recited in Claim 1 for example. Additionally, Applicants respectfully direct the Examiner’s attention to at least Page 7, Line 25 through Page 8, Line 24 of the Specification, which provide an example description of the term client.<sup>1</sup>

Second, the Examiner states that “claim 1 states a client monitor operable to . . . a monitor as disclosed is merely an apparatus used to display information the monitor does not do the execution. Is the client intending to claim a client processor?” (Office Action, Page 2)

Applicants respectfully submit that those of ordinary skill in the art would understand the meaning of the term “client monitor,” as recited in Claim 1 for example. Additionally, Applicants respectfully direct the Examiner’s attention to at least Page 3, Lines 8-20; Page 8, Line 25 through Page 9, Line 2; Page 10, Line 23 through Page 12, Line 12; and Page 32, Line 15 through Page 33, Line 5 of the Specification, which provide an example description of the client monitor recited in Claim 1. Moreover, client monitor 56 is clearly shown in Applicants’ FIG. 1. Furthermore, Applicants are unclear as to what specific disclosure in Applicants’ Specification the Examiner is referring to in the following statement from the Office Action: a monitor as disclosed is merely an apparatus used to display information the monitor does not do the execution. (See Office Action, Page 2)

Applicants note that paragraph number five of the Office Action merely includes an incomplete sentence. (See Office Action, Page 2) Thus, the Examiner’s thoughts were not completely conveyed to Applicants. In the unlikely event that the Examiner maintains the rejections under 35 U.S.C. § 112, second paragraph, Applicants respectfully request that the Examiner clarify paragraph number five of the rejection.

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<sup>1</sup> Applicants note that references to Applicants’ Specification are provided for example purposes only and should not be used to limit the scope of Applicants’ claims.

For at least these reasons, Applicants respectfully submit that independent Claim 1 and its dependent claims comply with 35 U.S.C. § 112, second paragraph. For at least certain analogous reasons, Applicants respectfully submit that independent Claims 39 and 51 and their dependent claims comply with 35 U.S.C. § 112, second paragraph.

**II. The Non-Statutory Double Patenting Rejection should be Withdrawn**

The Examiner rejects Claims 1-62 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of U.S. Patent 6,801,618 to Nygren et al. (the '618 Patent). Applicants respectfully traverse this rejection.

**A. The Obviousness-Type Double Patenting Standard**

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of an invention claimed in the patent? *See* M.P.E.P. § 804(II)(B)(1). An obviousness-type double patenting rejection is proper only when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. *Id.* The term “distinct” means two or more subjects as disclosed are related, for example, as combination and sub-combination thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of prior art). *See* M.P.E.P. § 802.01. *Any analysis employed in an obviousness-type double patenting rejection (if not based on an anticipation rationale) parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. Id.* A double patenting rejection must rely on a comparison with *the claims* in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. § 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued patent. *See* M.P.E.P. § 804(III).

The Office Action should make clear the differences between the inventions defined by the conflicting claims, and the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue would have been an obvious

variation of the invention defined in a claim in the patent. *See* MPEP § 804. This analysis requires a comparison of each rejected claim in the application with a claim in the patent. *See id.*

**B. The Applicable Obviousness Standard under 35 U.S.C. § 103**

The question raised under 35 U.S.C. § 103 is whether the cited reference (*i.e.*, the '618 Patent) taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various references, which is certainly not the case here as the Examiner acknowledges, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference to arrive at the claimed invention. It is clear based at least on the many distinctions discussed below that the proposed modifications to the claims of '618 Patent do not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted).

**C. A *Prima Facie* Case of Obviousness has not been Established**

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to Claims 1-62 of the present Application in view of Claims 1-24 of

the '618 Patent. Thus, Applicants respectfully request the Examiner to withdraw the obviousness-type double patenting rejection.

The Examiner acknowledges that the claims of the '618 Patent are "not identical" to the claims in the present Application but states that they are not patentably distinct from each other "because the claimed subject matter is fully disclosed in the disclosure of the ['618 Patent]." (Office Action, Page 3) According to the Examiner, the "independent instant application is narrow interpretation and an obvious variant of the claims of '618 but the variation is completely disclosed as the specifications of the patent and instant application are identical." (Office Action, Page 3)

Applicants respectfully submit that the Examiner improperly relies on what is described in the disclosure of the '618 Patent. When determining whether a double-patenting rejection is appropriate with respect to a prior patent, the only portion of the prior patent that is relevant is the claims. *See* M.P.E.P. § 804(III) (stating that a double patenting rejection must rely on a comparison with *the claims* in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. § 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued patent). Thus, even if the "claimed subject matter is fully disclosed in the disclosure of the above noted patent [the '618 Patent]," as stated by the Examiner, that fact would have no bearing on whether a double-patenting rejection is appropriate. Moreover, the fact that "the variation [between the claims of the '618 Patent and the claims of the current Application] is completely disclosed as the specifications of the patent and instant application are identical," as stated by the Examiner, also has no bearing on whether a double-patenting rejection is appropriate.

Applicants respectfully submits that a comparison of each of the limitations of each of the rejected claims to the claims of the '618 Patent reveals that Claims 1-62 of the present Application are not merely obvious variations of Claims 1-24 of the '618 Patent. The claims of the present Application recite numerous limitations that are not specifically recited in



Claims 1-24 of the '618 Patent. These limitations are not obvious variations of, and are therefore patentably distinguishable from, Claims 1-24 of the '618 Patent.

Applicants request that, to the extent that the Examiner intends to maintain the obviousness-type double patenting rejection of Claims 1-62 over the '618 Patent, the Examiner provide a comparison of each rejected claim in the present application with a claim or claims in the '618 Patent, in accordance with MPEP § 804 (stating that the comparison between the claims of the patent and the claims of the patent application requires a comparison of each rejected claim in the application with a claim in the patent), 37 C.F.R. 1.104 (c)(2) and 35 U.S.C. § 132. The Examiner did not provide this analysis in the current Office Action.

Although Applicants do not necessarily agree that the Examiner's rejection is appropriate, Applicants note that if the double-patenting rejection were the only issue remaining in the case, Applicants would consider filing a Terminal Disclaimer pursuant to 37 C.F.R. § 1.321(c) to overcome these obviousness-type double patenting rejections.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the non-statutory obviousness-type double patenting rejection of independent Claims 1, 39, and 51 and their dependent claims.

### **III. Claims 1-62 are Allowable over *Nelkenbaum***

The Examiner rejects Claims 1-62 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 20020071529 A1 filed by Nelkenbaum ("*Nelkenbaum*"). Applicants respectfully traverse these rejections.

"A claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re*

*Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131. As illustrated below, *Nelkenbaum* fails to disclose, either expressly or inherently, each and every limitation recited in Applicants' claims, as is required under the M.P.E.P. and governing Federal Circuit cases.

**A. Independent Claim 1 and its Dependent Claims are Allowable over *Nelkenbaum***

At a minimum, *Nelkenbaum* fails to disclose, teach, or suggest each of the following limitations recited in independent Claim 1:

- a client monitor operable to . . . generate a presence message signifying the presence of a client on a network associated with the system, wherein the presence message comprises a presence type and a client identity; and
- a plan manager operable to, when executed by at least one of the one or more processing units:
  - receive the presence message from the client monitor;
  - retrieve a plan template in response to receiving the presence message, wherein the plan template is retrieved based upon the client identity and the presence type; and
  - create a recording plan associated with the client based at least in part upon the plan template.

For example, *Nelkenbaum* fails to disclose, teach, or suggest “a client monitor operable to . . . generate a presence message signifying the presence of a client on a network associated with the system, wherein the presence message comprises a presence type and a client identity,” as recited in Claim 1. It appears to Applicants that the Examiner does not even consider each and every limitation recited in this element of Claim 1. For example, the Examiner simply refers to “[c]lient computer generating a presence message” and cites page 7, paragraphs 86 and 88 of *Nelkenbaum*. (Office Action, Page 4) However, Claim 1 actually recites that the presence message signifies the presence of a client on a network associated with the system, and that the presence message comprises a presence type and a client identity. It does not appear to Applicants that the cited portions of *Nelkenbaum* disclose, teach, or suggest any specific presence message that signifies the presence of a client on a network *and* comprises *both* a presence type and a client identity, as recited in Claim 1. While the cited portion of *Nelkenbaum* discloses predefined recorded numbers (PRNs), nowhere does the cited portion disclose, teach, or suggest a specific presence message that

signifies the presence of a client on a network *and* comprises *both* a presence type and a client identity, as recited in Claim 1.

As another example, at least because the cited portions of *Nelkenbaum* fail to disclose, teach, or suggest a client computer operable to generate a presence message as recited in Claim 1, *Nelkenbaum* necessarily fails to disclose, teach, or suggest a plan manager that is operable to “receive *the presence message* from the client monitor,” as recited in Claim 1.

As another example, *Nelkenbaum* fails to disclose, teach, or suggest a plan manager that is operable to “retrieve a plan template in response to receiving the presence message, wherein the plan template is retrieved based upon the client identity and the presence type,” as recited in Claim 1. Again, it appears that the Examiner ignores various limitations recited in this element of Claim 1. For example, the Examiner simply refers to “retrieving plan template according to client identity” and cites page 7, paragraphs 84 and 88 and page 10, Claim 1 of *Nelkenbaum*. However, Claim 1 actually recites a plan manager that is operable to “retrieve a plan template in response to receiving the presence message, wherein *the plan template is retrieved based upon the client identity and the presence type.*” Therefore, as recited in Claim 1, the plan template is retrieved based on *both* the client identity *and* the presence type.

At least because *Nelkenbaum* fails to disclose, teach, or suggest a presence message that comprises a presence type and a client identity, as recited in Claim 1, *Nelkenbaum* necessarily fails to disclose, teach, or suggest a plan manager that is operable to “retrieve a plan template in response to receiving the presence message, *wherein the plan template is retrieved based upon the client identity and the presence type,*” as recited in Claim 1. Moreover, it is entirely unclear to Applicants what particular disclosure in the cited portion of *Nelkenbaum* the Examiner is attempting to equate with the plan template recited in Claim 1.

As another example, *Nelkenbaum* fails to disclose, teach, or suggest a plan manager that is operable to “create a recording plan associated with the client based at least in part upon the plan template,” as recited in Claim 1. Again, it appears that the Examiner ignores various limitations recited in this element of Claim 1. For example, the Examiner simply refers to “developing a recording place associated with client” and cites page 7, paragraph 91



of *Nelkenbaum*. However, Claim 1 actually recites a plan manager that is operable to “create a recording *plan* associated with the client *based at least in part upon the plan template [that is retrieved based upon the client identify and the presence type]*.”

At least because *Nelkenbaum* fails to disclose, teach, or suggest a plan manager that is operable to “retrieve a plan template in response to receiving the presence message,” as recited in Claim 1, *Nelkenbaum* necessarily fails to disclose, teach, or suggest that the plan manager is operable to “create a recording plan associated with the client based at least in part upon the plan template,” as recited in Claim 1. Moreover, nowhere does the cited portion of *Nelkenbaum* disclose, teach, or suggest that the correlation criterion disclosed in the cited portion of *Nelkenbaum* has anything to do with a plan manager that is operable to “create a recording plan associated with the client based at least in part upon a plan template,” as recited in Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims.

**B. Independent Claims 39 and 51 and their Dependent Claims are Allowable over *Nelkenbaum***

*Nelkenbaum* also fails to disclose, teach, or suggest various limitations recited in independent Claim 39 (which Applicants discuss as an example). At a minimum, *Nelkenbaum* fails to disclose, teach, or suggest a processor coupled to a memory [that is operable to store a plurality of plan templates and client information] and operable to:

- receive a presence message signifying the presence of a client on a network associated with the system, the presence message comprising a presence type and a client identity;
- retrieve a plan template from the memory in response to receiving the presence message, wherein the plan template is retrieved based upon the client identity and the presence type; and
- create a recording plan associated with the client based at least in part upon the plan template.

For example, *Nelkenbaum* fails to disclose, teach, or suggest a memory that is operable to store a plurality of plan templates and client information, as recited in Claim 39. Indeed, it does not even appear to Applicants that the Examiner has cited any portion of

*Nelkenbaum* as allegedly disclosing a memory that stores such a plurality of plan templates and client information. Applicants respectfully submit that the portions of *Nelkenbaum* cited with respect to the other limitations in Applicants' independent claims do not disclose, teach, or suggest such a memory.

As another example, *Nelkenbaum* fails to disclose, teach, or suggest a processor that is operable to "receive a presence message signifying the presence of a client on a network associated with the system, the presence message comprising a presence type and a client identity," as recited in Claim 39. Applicants reiterate that it appears the Examiner has ignored various limitations recited in this element of Claim 39. Moreover, as Applicants demonstrated above with respect to Claim 1, the cited portions of *Nelkenbaum* do not appear to disclose, teach, or suggest a presence message that signifies the presence of a client on a network associated with the system and comprises both a presence type and a client identity.

As another example, *Nelkenbaum* fails to disclose, teach, or suggest a processor that is operable to "retrieve a plan template from the memory in response to receiving the presence message, wherein the plan template is retrieved based upon the client identity and the presence type," as recited in Claim 39. Applicants reiterate that it appears the Examiner has ignored various limitations recited in this element of Claim 39. Additionally, at least because *Nelkenbaum* fails to disclose, teach, or suggest a memory operable to store a plurality of plan templates and a presence message that comprises a presence type and a client identity, *Nelkenbaum* necessarily fails to disclose, teach, or suggest a processor that is operable to "***retrieve a plan template from the memory*** in response to receiving the presence message, ***wherein the plan template is retrieved based upon the client identity and the presence type,***" as recited in Claim 39. Moreover, as Applicants demonstrated above with respect to Claim 1, the cited portions of *Nelkenbaum* do not appear to disclose, teach, or suggest a presence message that signifies the presence of a client on a network associated with the system and comprises both a presence type and a client identity.

As another example, *Nelkenbaum* fails to disclose, teach, or suggest a processor that is operable to "create a recording plan associated with the client based at least in part upon the plan template," as recited in Claim 39. Applicants reiterate that it appears the Examiner has ignored various limitations recited in this element of Claim 39. Additionally, at least because

*Nelkenbaum* fails to disclose, teach, or suggest a memory operable to store a plurality of plan templates, a presence message that comprises a presence type and a client identity, and a processor that is operable to “retrieve a plan template from the memory in response to receiving the presence message, wherein the plan template is retrieved based upon the client identity and the presence type,” *Nelkenbaum* necessarily fails to disclose, teach, or suggest that the processor is operable to “create a recording plan associated with the client ***based at least in part upon the plan template***,” as recited in Claim 39. Moreover, as Applicants demonstrated above with respect to Claim 1, the cited portions of *Nelkenbaum* do not appear to disclose, teach, or suggest a processor that is operable to “create a recording plan associated with the client based at least in part upon a plan template,” as recited in Claim 39.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 39 and its dependent claims.

For at least certain reasons analogous to those discussed above with reference to independent Claim 39, Applicants respectfully submit that *Nelkenbaum* fails to disclose, teach, or suggest various limitations recited in independent Claim 51. Thus, Applicants respectfully request reconsideration and allowance of independent Claim 51 and its dependent claims.

#### IV. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner’s rejections.

**Conclusion**

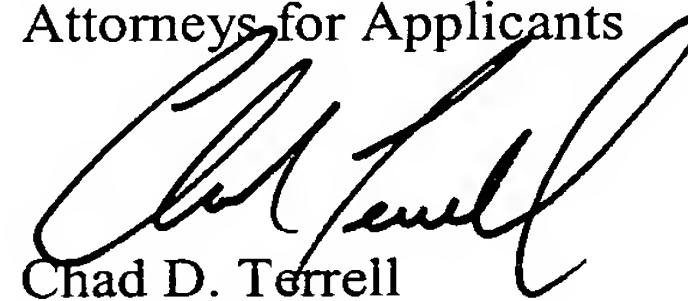
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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